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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/588,784	08/08/2006	Yoshinori Gondoh	10993.0275	4008
22852	7590	07/20/2010		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER CHOI, PETER Y	
			ART UNIT 1786	PAPER NUMBER
			MAIL DATE 07/20/2010	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/588,784

Applicant(s)

GONDOH ET AL.

Examiner

PETER Y. CHOI

Art Unit

1786

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4 and 11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4 and 11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8506)
Paper No(s)/Mail Date 03/15/10 and 06/22/10
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicants' submission filed on June 22, 2010, has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3, 4, and 11 are rejected under 35 U.S.C. 103(a) as obvious over USPN 5,175,034 to De La Porte.

Regarding claims 1, 3, 4, and 11, De La Porte teaches a double glass cloth, comprising a double glass cloth which is composed of warps and wefts, and has a double structure comprising a face side structure and a back side structure, wherein the face side structure and the back side structure form two layers and are bound with a woven structure into one piece, wherein the face side structure comprises face side warps which only weave the face side structure, face side wefts which only weave the face side structure and common yarns which weave both the face side structure and the back side structure, and the back side structure comprises back side warps

which only weave the back side structure, back side wefts which only weave the back side structure and the common yarns which weave both the face side structure and the back side structure, the common yarns constituting a woven structure binding the face side structure and the back side structure or a part thereof (De La Porte, column 1 line 4 to column 2 line 35, column 3 line to column 5 line 27, Figures 1-5).

It should be noted that Applicants' specification does not specify what surface the glass cloth is viewed from, or the manner in which a surface of the glass cloth is viewed. Therefore, for purposes of examination, at least the side surface of the double glass cloth is interpreted as being within the scope of the claimed surface. Additionally, it would have been obvious to one of ordinary skill in the double glass cloth art at the time the invention was made to form the double glass cloth of the prior art, wherein each of the face cloth and back cloth are separated from each other, as the prior art teaches and suggests such a structure to improve the deformability for stress diversions, and motivated by the desire of forming a conventional double glass cloth with improved deformability for stress diversions, suitable for intended application. Therefore, since the prior art teaches a substantially similar structure as the claimed invention, wherein the face cloth and back cloth are separated from each other and therefore the warp and wefts of each of the cloths do not overlap, the prior art structure appears to meet the limitation of the claim, absent evidence to the contrary.

Regarding claims 1, 3, 4, and 11, although the prior art does not appear to specifically disclose that the cloth is for a printed wiring board, the limitation is recited in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the intended use of a structure, and where the body of the claim does not depend on the preamble for

completeness but, instead, the structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Additionally, the recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Since the prior art teaches a substantially similar structure and composition as the claimed double glass cloth, the invention of the prior art appears to be capable of performing the claimed intended use.

Regarding claims 3 and 4, the prior art teaches that the face side structure and back side structure comprise a plain weave (De La Porte, column 3 lines 22-49).

Regarding claim 4, the prior art teaches that the face side structure and back side structure are bound together at a rate of at least one location per unit structure (De La Porte, column 1 line 4 to column 2 line 35, column 3 lines 22-49, column 4 line 24 to column 5 line 2, Figures 1-3). Additionally, it would have been obvious to one of ordinary skill in the art at the time the invention was made to bind the face side structure and the back side structure with a desired rate, as it is within the level of ordinary skill to determine a suitable rate to bind the face side and back side structure based on the desired cohesion of the materials, such that binding at a higher rate would result in a stiffer, stronger, denser and less flexible structure.

Regarding claim 11, although the prior art does not appear to teach that the double glass cloth has been subjected to a fiber-opening processing by a water flow pressure or by vibration at high frequency using a liquid as a medium, such a limitation appears to be a product by process limitation. Absent a showing to the contrary, it is Examiner's position that the article of the

applied prior art is identical to or only slightly different than the claimed article. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. The burden has been shifted to Applicants to show unobvious difference between the claimed product and the prior art product. The applied prior art either anticipated or strongly suggested the claimed subject matter. It is noted that if Applicants intend to rely on Examples in the specification or in a submitted declaration to show unobviousness, Applicants should clearly state how the Examples of the present invention are commensurate in scope with the claims and how the Comparative Examples are commensurate in scope with the applied prior art.

4. Claim 11 is rejected under 35 U.S.C. 103(a) as obvious over De La Porte in view of Applicants' specification.

Regarding claim 11, the prior art appears to teach a substantially similar structure and composition as the claimed invention. Additionally and/or alternatively, although the prior art does not appear to specifically teach that the double glass cloth has been subjected to a fiber-opening process, Applicants' specification expressly teaches that it was known in the glass cloth art at the time the invention was made to subject woven glass cloth to a fiber-opening process to reduce the variation in the amount of glass in the thickness direction and in the shape of holes (see Applicants' specification at pages 5 and 6). It would have been obvious to one of ordinary

skill in the glass cloth art at the time the invention was made to form the double glass cloth of the prior art, wherein the double glass cloth has been subjected to a fiber-opening process, as disclosed by Applicants' specification, motivated by the desire of forming a conventional double glass cloth which has been subjected to a known process which is known to advantageously reduce the variation in the amount of glass in the thickness direction and in the shape of holes, and such a process would yield a predictably resulting double glass cloth, suitable for the intended application.

Response to Arguments

5. Applicants' arguments filed June 22, 2010, have been fully considered but they are not persuasive. Applicants argue that the pile threads do not constitute a woven structure binding the face side and the back side or a part thereof. Examiner respectfully disagrees. For example, the prior art teaches that the pile threads can be laid in a weave (*see for example* De La Porte, column 1 line 67 to column 2 line 16, column 3 lines 22-49). Therefore, the pile threads of the prior art are within the scope of the claimed common yarns and the claimed structure.

Applicants argue that the double cloth of Figure 1 has a structure such that the advantageous effect of the present invention cannot be obtained. Examiner respectfully disagrees. Applicants are not setting forth any structural and/or compositional differences between the claimed invention and the invention of the prior art, as Applicants are only arguing that the advantageous effect of the claimed invention differs from the prior art. However, Applicants do not claim any advantageous effect resulting from the claimed invention. Additionally and/or alternatively, Applicants do not set forth evidence that the prior art invention

necessarily does not additionally comprise substantially similar and/or identical advantageous effects.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PETER Y. CHOI whose telephone number is (571)272-6730. The examiner can normally be reached on Monday - Friday, 08:00 - 15:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Tarazano can be reached on (571) 272-1515. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Peter Y Choi /PYC/
Examiner, Art Unit 1786

/D. Lawrence Tarazano/
Supervisory Patent Examiner, Art Unit
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